

REMARKS

I. Status of Claims

Claims 1-10, 12-18, 23-34 and 37-44 are currently pending. Applicants propose to amend claims 1, 37, 39 and 41 as shown above. The Examiner has withdrawn from consideration claims 13, 15, 23-29, and 37-44, and claims 11, 19-22, 25, 26, 35, and 36 were cancelled by Applicants. Thus, claims 1-10, 12, 14, 16-18, and 30-34 are under consideration on the merits.

As shown, Applicants propose to amend independent claims 1, 37, 39 and 41 to further define the claimed silicone as not including silicone gums, and to remove silicone resins from the set of options from which the at least one non-volatile polyorganosiloxane is chosen. Support for these amendments can be found in the original specification, for example, claims 20 and 21 which show through claim differentiation that the composition may comprise many types of non-volatile polyorganosiloxanes that are not gums. Accordingly, Applicants submit that the above amendments raise no issue of new matter, and are fully supported by the original disclosure.

II. Rejections under 35 U.S.C. § 103(a)

In the final Office Action of February 18, 2009, the Examiner rejected claims 1-10, 12, 14, 16-18, and 30-34 as allegedly unpatentable over Murray¹, Sweger², Babenko³, Saint Leger⁴, and Harashima⁵ for the reasons of record. See Office Action at

¹ Murray, U.S. Patent No. 5,720,964, issued February 24, 1998.

² Sweger et al., U.S. Patent No. 5,482,704, issued Jan. 9, 1996.

³ Babenko, U.S. Patent No. 6,277,893, issued Aug. 21, 2001.

2-6. Applicants continue to disagree with this rejection, and respectfully submit that the claims as amended are not *prima facie* obvious for at least the following reasons.

Murray was cited as the primary reference in the obviousness rejection. Murray states, at the beginning of its Specification,

This invention relates to hair conditioning compositions containing non-volatile insoluble silicone gum, particularly dimethiconol gum. *Col. 1, ll. 5-7.*

Thus, the use of silicone gum is a defining feature of the invention disclosed by Murray. Indeed, in the Examples, only dimethiconol is mentioned as a specific type of silicone that was actually used in the disclosure of Murray. *Id.* at *col. 6, ll. 41-44.*

Murray states,

The two attributes considered to be most indicative of conditioning benefit are (a) ease of dry combing and (b) smooth feel of the hair when dry. Comparative example A was found to be equivalent to the control in both tests. Example 1 was found to be superior to the control in both tests. This shows that the emulsion polymerized dimethiconol material of example 1 has superior hair conditioning properties to the mechanically emulsified silicone of comparative example A. *Col. 6, ll. 36-44.*

There is no teaching or suggestion that other silicones are equivalents of the gum chosen by Murray as the defining feature of its disclosed invention.

Applicants' claims as amended exclude silicone gums. Amendment of claims to exclude material is consistent with *In re Johnson*, 558 F.2d 1008, 194 U.S.P.Q. 187, 196 (CCPA 1977):

(...continued)

⁴ Saint Leger, U.S. Patent No. 5,919,438, issued July 6, 1999.

⁵ Harashima, European Patent Specification No. 0 268 981 B1, published March 25, 1992.

Here, as we hold on the facts of this case, the "written description" in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter."

Thus, this opinion is authority for the proposition that Applicants, having described a genus and some species, may claim the genus minus certain species. Applicants' claims as amended expressly exclude the disclosure of Murray. This deficiency is not remedied by Sweger, Babenko, Saint Leger, or Harashima. Sweger does not discuss insoluble silicones at all, and therefore can provide no reason why one of ordinary skill would not follow the defining feature of Murray. Babenko is similarly silent on the matter of insoluble silicones. The only disclosure of Saint Leger concerning silicone or silicon is the use of "Silicon gum marketed under the trademark QC F2-1671 by Dow Corning" in Example 3. *Saint Leger at col. 4, ll. 56-57*. The use of such a gum is consistent with the teaching of Murray and does not fall within Applicants' claims as amended. Applicants courteously point out that Harashima represents an attempt to solve a problem related to instability through the use of emulsion polymerization:

However, even cosmetics obtained by emulsification using the above specific surfactants suffer from a lack of long term stability due to the organopolysiloxane emulsion having an average particle size above 0.2 micrometers. As a consequence, when blended with other cosmetic starting materials, the organopolysiloxane will separate out during long-term storage. . . . The object of the present invention is to eliminate the aforesaid problem by providing a cosmetic which is based on an organopolysiloxane microemulsion

prepared by emulsion polymerization, and which has excellent storage stability. *Harashima at 2, ll. 20-23, 28-30.*

The use of emulsion polymerization is consistent with the disclosure of Murray. *See, e.g., Murray at col. 1, ll. 15-16, citing EP 0 268 982 (Toray)*⁶. Again, the disclosure of Harashima, which preceded that of Murray, would not motivate or suggest deviation from the defining feature of Murray.

For at least the foregoing reasons, Applicants respectfully submit that the cited references do not support a *prima facie* case of obviousness against Applicants' claims as amended. Given the presence of an insoluble silicone gum as a defining feature of Murray and secondary references either consistent with or irrelevant to this feature, there is no credible explanation of how one of ordinary skill in the art would arrive at the invention of Applicants' claims as amended. Applicants therefore aver that the 35 U.S.C. § 103(a) rejection is improper in view of the pending claims, and should be withdrawn.

⁶ Toray is the applicant to which the European patent for the invention of Harashima et al. issued.

III. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-10, 12-18, 23-34 and 37-44 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 37, 39 and 41 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.


In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any required fees to Deposit Account 06-0916.

Respectfully submitted,

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